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# The technical judges of the Unified Patent Court

- scientific complexity & patent litigation -

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**Xavier Seuba**

Senior Lecturer

Centre for International Intellectual Property Studies  
(CEIPI), University of Strasbourg

# INTRODUCTION

## IP, the judiciary and... IP enforcement

- Enforcement, “activity by which a legally constituted power is applied to make the law’s dictates actual” (Kleinfeld, 2011).
- The judge determines the facts and interprets “law’s dictates”.
- “Without effective enforcement, IPRs are nothing but empty shells” (Hilty, 2012)

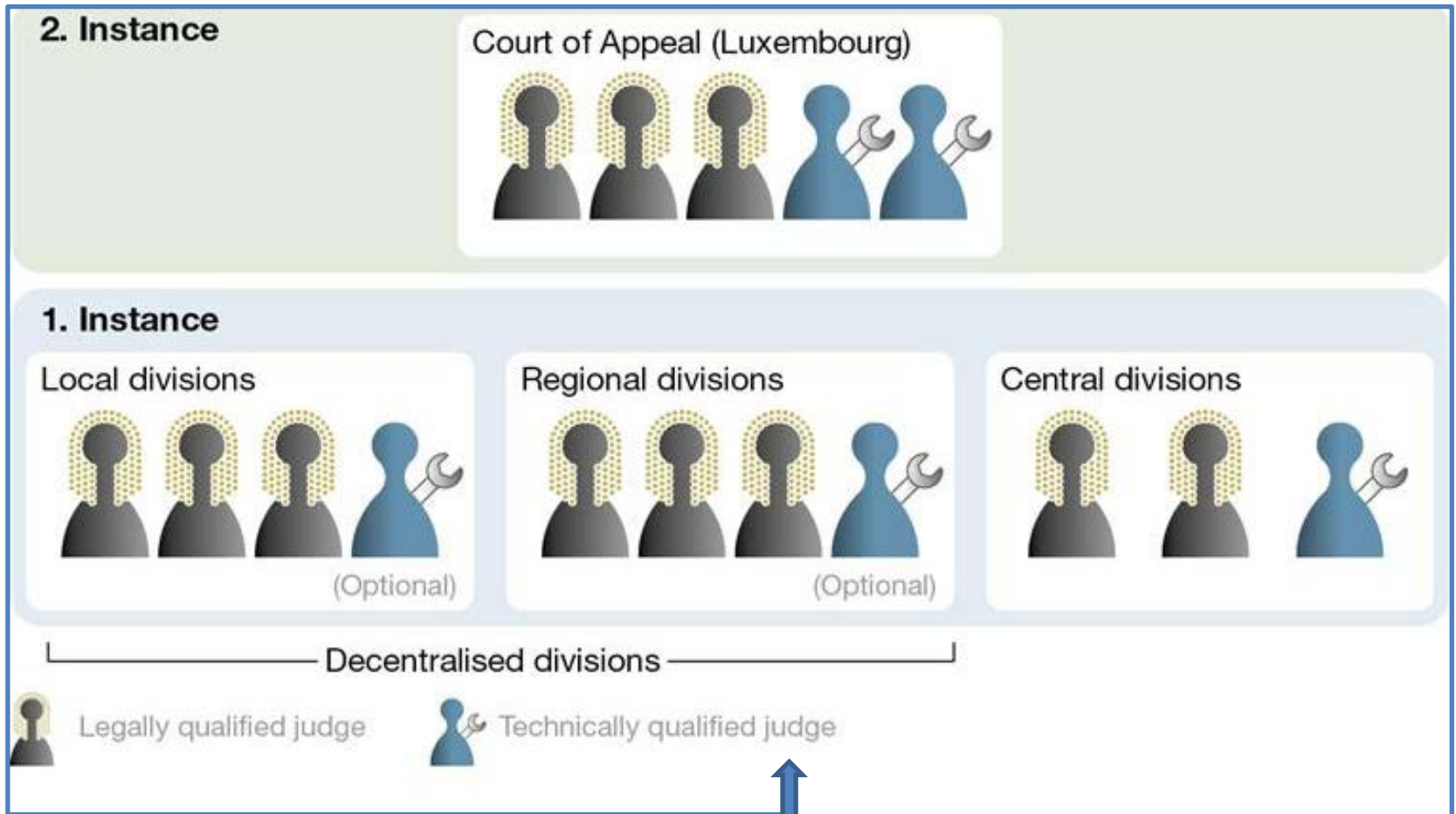
## Unified Patent Court and specialization

- The creation and design of the UPC stimulates the discussion on harmonization, internationalization and specialization
- TQJ: specialization within specialized courts

## TQJ stimulate reflection on...

- Technical & scientific **complexity** in patent litigation
- Epistemic **asymmetries**
- Institutional **design** and judicial policy
- Relationship between IP & **broader legal order**

# TECHNICAL JUDGES OF THE UPC



- If one of the parties requests it
- In case of counterclaim for revocation

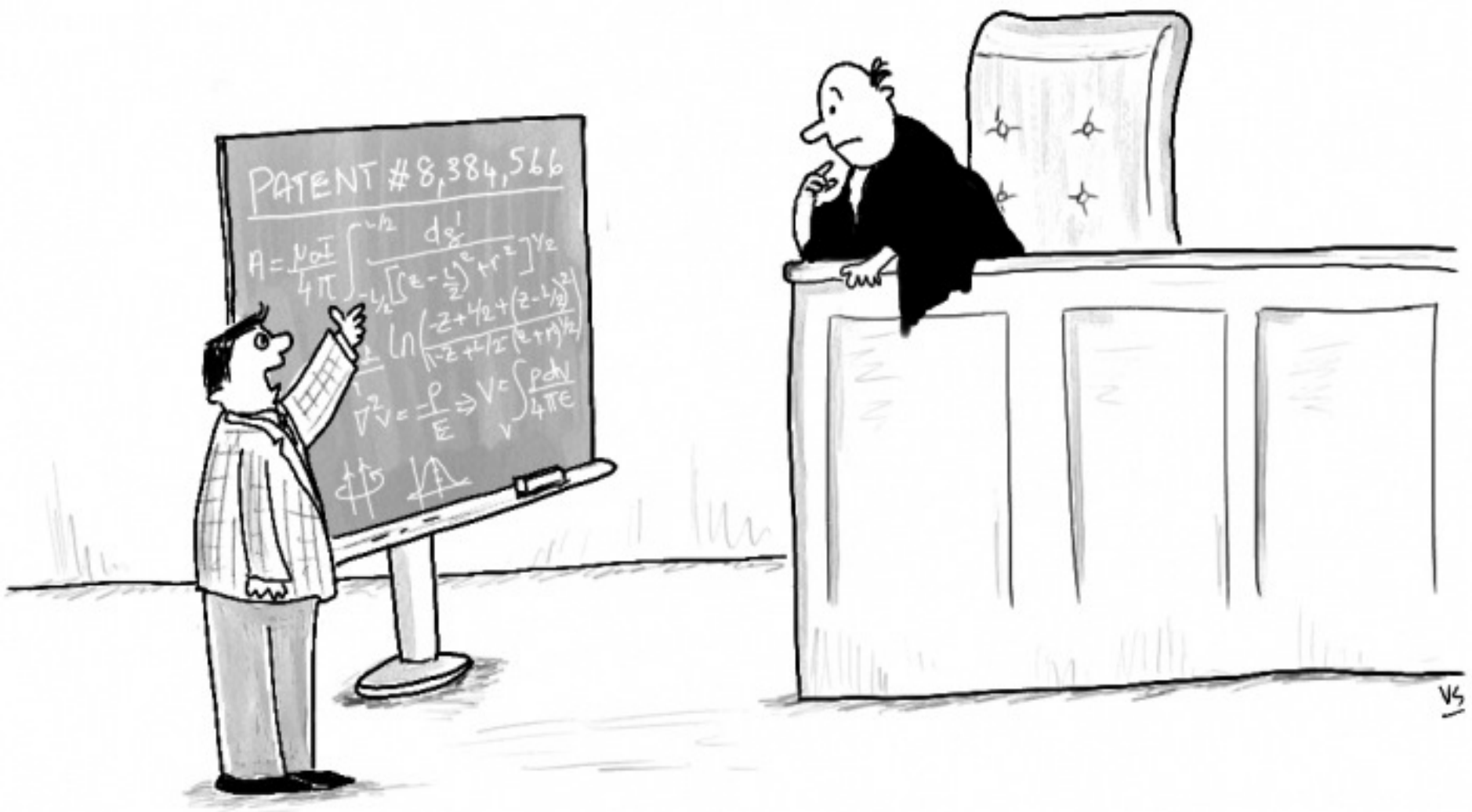
- **Proposals** to count with technical judges...
  - ... date back to **Community Patent Jurisdiction** (2002)
  - ... disappeared and were reintroduced in the EPLA (2007).
- **Requirements** to become a technical judge of the UPC
  - Many are the **same** as those in international dispute settlement forums (nationality, high standards of expertise)
  - Other are **specific** to technical judge
    - degree in sciences
    - proven experience in a technical field
    - experience in patent litigation
    - knowledge of civil law and procedure relevant to patent litigation
- **Diversity: one** technical judge **per** relevant **field** of technology in the pool of judges

Patent-inexperienced judges must often spend an “inordinate expense of time” merely to understand the technological jargon and pass on technological issues. *Parke-Davis v. Mulford*, 189 Fed. 95 at 115 (S.D. N.Y. 1911)



“This patent appeal is another illustration of the absurdity of requiring the decision of such cases to be made by judges whose knowledge of the relevant technology derives primarily, or even solely, from explanations of counsel and who, unlike the judges of the Court of Customs and Patent Appeals, do not have access to a scientifically knowledgeable staff”

*General Tire & Rubber Co. v. Jefferson Chem. Co.*, 497 F.2d 1283, 1284



*"So you see your honor, it's obvious."*

# Epistemic Asymmetry

- Situation between traditional **judges and technical experts**
  - One of them is aware about something that the other is not
  - Law has a technical or scientific dimension which judges discover or assess with the assistance of technical experts
- **Adversarial and inquisitorial systems** address asymmetry differently
  - Adversarial systems: expert witnesses have a central role, since the court is primarily an impartial referee.
  - Inquisitorial systems: engage the judge in determining the facts and promote the presence of court-appointed experts and in-house expertise.

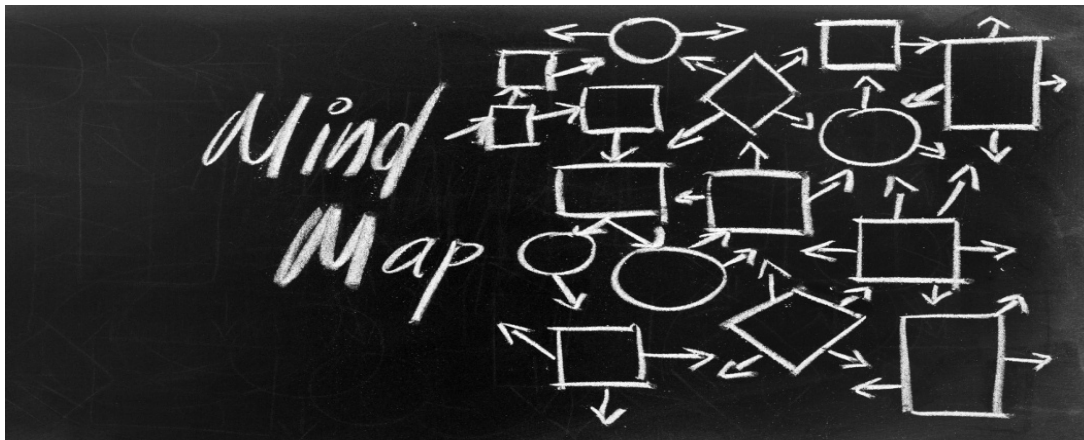


# Responses to technical complexity

## Traditional approaches

- Expert witnesses
  - Translators & educators to the judge... Independence?
  - Expert witness “may hide behind an impenetrable wall of esoteric knowledge” (R. Posner, 1999).
- Court-appointed experts – mitigate that risk

## Integration of expertise & adjudication



- Specialized courts
- Training of judges
- External advisors
- In-house experts
- Technical judges

# The technical judge: validity... and infringement

- The technical judge
  - Translates technical matters to his colleagues and points out possible technical pitfalls
  - Ensures that the panel understands the relevant technical facts
- TQJ are more frequent in dual systems (Austria, Hungary, Germany) but not only:
  - Single system + technical judges: Switzerland, Sweden, Denmark
  - Single system + judges with scientific background: UK, The Netherlands

# Advantages of counting with TQJ

## Quality

- Keep up with scientific developments & patent practices
- Clear identification of facts & ask the right questions
- Reduced risk of factual errors

## Fair trial

- Right to reasoned sentence - judge understands the facts

## Time & Money

- The creation of a report by a technical judge is about 12 times faster and 50-70% cheaper than a report by a court-appointed expert (President of the Swiss Patent Court)

## Welfare

- Specialization thanks to the TQJ will contribute to the overall welfare effects of the UPC (D. Harhoff)

## Risks of specialization and TQJ

- Need of substantial **volume** of case-law to justify full-time TQJ
- Difficult **coexistence** between legal and technical experts...
- **Fair trial**: should technical judges, passing sentences, have also a degree in law?
- Possible **conflicts of interest**
- Promotion of a **'tunnel vision'** or a **'myopic view of the law'**
  - “The patent law does not live in the seclusion and silence of a Trappist monastery. It is part and parcel of the whole body of our laws. It ministers to a system of monopolies within a larger competitive system” (Rifkind, 1951)

# Test: 'tunnel vision' + conflicts of interest

- Possible conflicts of interest:
  - Many UPC TQJ will be part-time judges, mostly patent attorneys working either in companies or in legal firms
  - UPC: 5 situations where a conflicts of interest exist: judges should not take part in the proceedings
    - Is this enough to guarantee the independence of the Court?
- In addition to the UPC situations, Swiss law identifies other conflicts of interest arising from
  - ... the relations between the parties to the procedure and the company or legal firm for which the judge works
  - ... family situations such as “registered partnership” or “co-habitation”
  - .... “friendship or enmity”
  - ... publicly stated opinions

- The 13<sup>th</sup> recital of the Preamble of the UPC Agreement
  - recognizes the primacy of the EU framework on human rights
  - alludes to the right to an effective remedy before an independent and impartial tribunal
- Charter of Fundamental Rights of the European Union establishes (Article 52.3)
  - Whenever the Charter contains rights that coincide with the ECHR, their scope and meaning will be the same
- ECHR, *Piersack v. Belgium* (1982), on conflicts of interest and independence:
  - it is necessary to satisfy both an objective and subjective standard on conflicts of interest
  - “it is not possible to confine oneself to a purely subjective test (...) any judge in respect of whom there is a legitimate reason to fear a lack of impartiality must withdraw. What is at stake is the confidence which the courts must inspire in the public in a democratic society.”

# CONCLUSIONS

- TQJ are part of a broader response to the technical & scientific complexity of patent law
- Integration of the function of the expert and adjudicator: specialization within specialization
- Probably a win for the inquisitorial system
- Risk of “tunnel vision”... can be avoided by taking into account the broader legal framework, as instructed in the Agreement: human rights norms should shape the activity and sentences of technical judges